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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,194	06/25/2003	Mark J. Radcliffe	MS1-1547US	5791

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EXAMINER	
CRABTREE, JOSHUA DAVID	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/25/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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lhptoms@leehayes.com

Office Action Summary	Application No.	Applicant(s)	
	10/607,194	RADCLIFFE ET AL.	
	Examiner	Art Unit	
	Joshua D. Crabtree	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/21/2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 32-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 32-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the amendment dated 12/21/2006, Claims 9-31 had been cancelled, and Claims 1-8 and 32-48 are pending. Applicant is notified that, upon reconsideration of the previous office action, the finality of the previous office action is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear whether claim 8 is an independent claim, or whether it depends from claim 1. Claim 8, drawn to an apparatus, recites one of more computer-readable memories containing a program to perform the method of claim 1. If claim 8 depends from claim 1, then it is unclear how an apparatus may constitute a step in a method. If claim 8 is independent, then it is vague and indefinite since it recites performing the method of claim 1, but does not list any of the limitations of claim 1. Therefore, the claim is rendered vague and indefinite. Similarly, claim 37 recites one or more computer-readable memories to perform the

method of claim 32. For the same reasons given above, claim 37 is rendered vague and indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3-8, 32, 33, 36-39, 41, 43, 44, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover et al. (US 5,469,370) in view of Baker (US 2005/0162551).

With regard to claims 1, 32, 43, and 46, and the limitation of receiving a user request to play an audio file, and identifying, based on the user request, a preferred language and a preferred sublanguage for displaying a lyric set associated with the audio file, Ostrover et al. disclose a system for controlling play of audio tracks, which may be used for karaoke entertainment (i.e., a song is requested, and lyrics are displayed while the song is played) (Col. 2: 38-41). Ostrover et al. disclose that a user may select the default language for display of subtitles (i.e., lyrics) (Col. 3: 16-20). If a user chooses to turn on the subtitles, the system then checks to see if the default

language is available. If the default language is not available, then a user may select an alternate language (Col. 25: 21-32).

With regard to the limitation of automatically searching a list of lyric sets associated with the audio file to determine whether the lyric set is available in the preferred language and the preferred sublanguage, Ostrover et al. disclose that the system automatically searches to see if the default language is available (Col. 25: 21-32).

With regard to claims 1, 32, 38, 43, and 46, the limitation of automatically selecting an alternate lyric set to be displayed based on a hierarchical list of language priorities provided by a lyric synchronization module when the automatic searching indicates that the lyric set is unavailable in the preferred sublanguage, the automatic selecting performed without user assistance, and playing the alternate lyric set, Ostrover et al. disclose that a user may select a default language, and that the system (or language selection module, as in claim 38) will search to see if subtitles are available in the default language, as previously described. If the default language is not available, the user may select an alternate language, as previously described.

With regard to claims 38 and 43, and the limitation of an audio player to play an audio file, Ostrover et al. disclose playing audio as part of the invention (Fig. 2, Items 71 and 91). With regard to the limitation of a lyric display module coupled to the audio player and language selection module, the lyric display module to identify the alternate lyric set associated with the audio file, wherein the lyric display module displays the identified lyric set synchronously with playing of the audio file, Ostrover et al. disclose

a display unit as part of the system (Item 94 in Fig. 2). Ostrover et al. disclose displaying subtitles for a motion picture, which would necessarily mean that the text is displayed synchronously with the audio (Col. 16: 55 - Col. 17: 26). Additionally, Ostrover et al. disclose that the invention may be used for karaoke, as previously noted (i.e., lyrics are displayed synchronously while songs are played).

With regard to claims 1, 32, 38, 43, 46, and 47, it is noted that Ostrover et al. disclose the feature wherein the selection of an alternate language is performed manually, rather than automatically, as claimed. However, the feature of providing an automatic or mechanical means to replace a manual activity which accomplishes the same result (i.e., selection of an alternate language) has been held to be insufficient to distinguish over the prior art. See MPEP 2144.04, III. (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

With regard to claims 1, 7, 32, 43, 44, and 46, Ostrover et al. do not explicitly disclose the feature wherein the available language choices include sublanguages. Baker teaches a closed-captioning system in which a plurality of regional dialects (i.e., sublanguages) may be used for captioning. Baker teaches that implementing this feature would merely require adding captions to a caption database (Paragraph [0015]). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teaching of Baker into the invention of Ostrover et al. in order to provide a captioning system that is capable of showing subtitles (or lyrics) in regional dialects of a language.

With regard to claims 3 and 41, and the limitation wherein the alternate lyric set is stored separately from the audio file, Ostrover et al. disclose the feature of individual audio tracks and subtitle tracks (Col. 4: 1-3).

With regard to claims 4, 6, 39, 43, and the limitation wherein the alternate lyric set includes a plurality of lyric segments, and wherein each of the plurality of lyric segments is associated with a particular time period of the audio file (as in claim 4), and wherein a particular lyric segment is displayed during playback of the audio file based on a current time code (as in claim 6), and wherein the lyric display module displays different lyric segments of the alternate lyric set based on a portion of the audio file being played in the audio player (as in claim 39), and a means for playing the audio file and displaying a lyric segment that correspond to the current time code (as in claim 43), Ostrover et al. disclose the feature of displaying subtitles for motion pictures (Col. 16: 55 - Col. 17: 26). Thus, each portion of the subtitle data would correspond to a particular scene (i.e., time segment) in the movie (or audio file). Additionally, Ostrover et al. disclose using digital audio and video files (Col. 5: 40-43), and that portions of audio tracks may correspond to specific portions of the video (Col. 6: 52-59). Ostrover et al. disclose subtitles for the motion picture, as previously described. Since a subtitle corresponds to the audio portion of a movie, and since the audio segments correspond to specific scenes (i.e., time segments in a movie), then the subtitles would also correspond to the scenes as well.

With regard to claims 5 and 48, Ostrover et al. disclose that digital audio files may be used, and that corresponding subtitles may be displayed (i.e., plurality of lyric segments), as previously described. With regard to the feature wherein the audio file contains a plurality of time codes (as in claim 5), or wherein the time code data is stored in the audio file (as in claim 48), Ostrover et al. disclose that the MPEG-1 and MPEG-2 formats may be used, which include the feature wherein time codes are included in the file (Col. 9: 26-30).

With regard to claim 36, and the feature of playing the audio file, Ostrover et al. disclose this feature, as previously described. With regard to the limitations of determining a time code associated with a current playback location in the audio file, identifying a lyric segment associated with the time code, and displaying the lyric segment until a different time code is reached, Ostrover et al. disclose using digital audio and video files (Col. 5: 40-43), and that portions of audio tracks may correspond to specific portions of the video (Col. 6: 52-59), as previously described. Ostrover et al. disclose subtitles for the motion picture, as previously described. Since a subtitle corresponds to the audio portion of a movie, and since the audio segments correspond to specific scenes (i.e., time segments in a movie), then the subtitles would also correspond to the scenes as well.

With regard to claims 8 and 37, and the limitation of one or more computer-readable memories containing a computer program that is executable by a processor to perform the method of claim 1, Ostrover et al. disclose that the invention may be

implemented with software (Col. 3: 21-30), and that a processor may control the system (Item 41 in Fig. 2).

With regard to claim 33, and the limitation of playing the audio file and displaying the associated lyric data in English if lyric data is not available in the preferred language or the alternate language, Ostrover et al. disclose that a player may have a default language, depending on where it is sold. This default language would be irrespective of a user's language preferences. Ostrover et al. provide an example in which a player sold in France might have French as the default language (Col. 3: 8-14). Additionally, Ostrover et al. disclose an example in which the default language may be English (Col. 23: 9-13).

With regard to claim 48, and the feature wherein the time code data is stored in the audio file, Ostrover et al. disclose

4. Claims 2, 34, 40, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover et al. (US 5,469,370) in view of Baker (US 2005/0162551), as applied above, and further in view of Parry (US 2002/ 0173968).

With regard to claims 2, 34, 40, and 45, Ostrover, as modified by Baker, do not explicitly disclose the limitation wherein the alternate lyric set is contained in the audio file. Parry teaches the feature of encoded audio files having embedded printable lyrics (Paragraph [0001]). Parry also teaches that the lyrics may either be embedded in the audio file or stored in another file (Paragraph [0008]). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teaching of

Parry into the invention of Ostrover et al., as modified by Baker, in order to simplify the complexity of the system by having a single storage space for an audio file containing lyric data, as opposed to two separate storage locations for audio data and lyric data.

5. **Claims 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover et al. (US 5,469,370) in view of Baker (US 2005/0162551), as applied above, and further in view of Tashiro et al. (US 5,654,516).**

With regard to claim 35, Ostrover et al., as modified by Baker, do not explicitly disclose the limitation of, while playing the audio file, receiving a request to change the language of the lyrics being displayed, and displaying the associated lyric data in the requested language. Tashiro et al. teach a karaoke system in which a user may switch the language of the words in the middle of a karaoke performance (Col. 11: 34-37). Since Ostrover et al. disclose that the invention may be used for karaoke purposes, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teaching of Tashiro et al. into the invention of Ostrover et al., as modified by Baker, in order to provide a karaoke entertainment system in which a user may switch the language in the middle of a song. With this feature, two performers who might speak different languages, could sing a song together. Additionally, a bilingual performer could perform a song and switch the language while performing.

With regard to claim 42, Ostrover et al., as modified by Baker, do not explicitly disclose the limitation of a synchronized lyric editor to edit the alternate lyric set associated with audio files. Tashiro et al. teach a karaoke system in which user may edit

the appearance of lyrics (such as by changing font size and letter type) (Col. 11: 29-34). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teaching of Tashiro et al. into the invention of Ostrover et al., as modified by Baker, in order to provide a karaoke entertainment system in which a user may edit the lyrics by changing the font size or letter type. With this feature, a user with poor eyesight could make the font size larger for easier reading.

Response to Arguments

6. Applicant's arguments with respect to claims1-8 and 32-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Crabtree whose telephone number is 571-272-8962. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC
Joshua D. Crabtree
January 11, 2007

Joe H. Cheng
Primary Examiner